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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,225	11/18/2003	Shen-Ling Allen Wang	G-00316-C/US	6740
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EXAMINER				
KRISHNAMURTHY, RAMESH				
ART UNIT		PAPER NUMBER		
3753				

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,225

Applicant(s)

WANG, SHEN-LING ALLEN

Examiner

Ramesh Krishnamurthy

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This office action is responsive to communications filed 11/18/2003.

Claims 1 – 13 are pending.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson et al. (US 2,624,587).

Watson et al. discloses (Figs. 1 – 6) a flapper valve (14,26,12,11), at least one post (12) extending from a first side of the flapper valve, a bead (12a) extending from the first side of the valve and a locator projection (15) having a ring shape extending from the first side thereof. A compression limiter (14) is also shown to be extending from the first side and the first and second posts extending from the compression limiter. A cover (10) is disclosed having a plurality of orifices (14d) with the first and second posts secured within the plurality of orifices. The post (12) has a cone shaped end (12d). Fig. 2 shows the valve to have a circular shape.

It is noted that recitations pertaining to “constant velocity joint” and “a vehicle” are not given any patentable weight in this office action, as they are reflective of intended use.

3. Claims 1 – 6, 8 - 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Caruso (US 3,354,903).

Caruso discloses (Figs. 1 – 5) a flapper valve (1), at least one post (5) extending from a first side of the flapper valve, a bead (4) extending from the first side of the valve and a locator projection (6) having a ring shape extending from the first side thereof. A compression limiter (12) is also shown to be extending from the first side and the first and second posts extending from the compression limiter. A cover (2) is disclosed having a plurality of orifices with the first and second posts secured within the plurality of orifices. Figs. 1 and 4 show the valve to have a circular shape.

It is noted that recitations pertaining to “constant velocity joint” and “a vehicle” are not given any patentable weight in this office action, as they are reflective of intended use.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al. (US 2,624,587).

Watson et al. discloses the claimed invention with the exception of explicitly disclosing the bead to have a generally half circle cross-section. The difference in cross section of the bead in Watson et al. from that recited in the claim pertains to a mere change in shape. The applicant should note that a change in the shape of a prior art device is a design consideration that involves only routine skill in the art. In re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1966).

6. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caruso (US 3,354,903).

Caruso discloses the claimed invention with the exception of explicitly disclosing (a) the post having a cone shaped end or (b) the bead to have a generally half circle cross-section. The difference in cross section of the bead or the end of the post in Caruso from that recited in the claim pertain to a mere change in shape. The applicant should note that a change in the shape of a prior art device is a design consideration that involves only routine skill in the art. In re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1966).

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 – 6 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,699,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of the U.S. Patent No. 6,699,129 includes all of

the limitations recited in claims 1 – 6 and 10 of the instant application, although claim 6 of U.S. Patent No. 6,699,129 has additional limitations.

9. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,699,129.

10. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,699,129.

11. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 1 of U.S. Patent No. 6,699,129. Claim 6 of U.S. Patent No. 6,699,129 recites all of the limitations with the exception of explicitly disclosing the post to have a conical shaped end. Claim 1 of the same U.S. Patent No. 6,699,129 discloses that it is known to have a conical shaped end for the post. The applicant should note that a change in the shape of a prior art device is a design consideration that involves only routine skill in the art. In re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1966).

12. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 4 of U.S. Patent No. 6,699,129. Claim 6 of U.S. Patent No. 6,699,129 recites all of the limitations with the exception of explicitly disclosing locator projection to have a ring-like shape. Claim 4 of the same U.S. Patent No. 6,699,129 discloses that it is known to have a circular i.e. ring-like shape for the locator projection. The applicant should note that a change in the shape of a prior art device is a design consideration that involves only routine skill in the art. In re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1966).

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13. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 4 of U.S. Patent No. 6,699,129. Claim 6 of U.S. Patent No. 6,699,129 recites all of the limitations with the exception of explicitly disclosing the valve to have a circular shape. Claim 4 of the same U.S. Patent No. 6,699,129 discloses that it is known to have a ring-like i.e. circular shape for the sealing bead. Claim 6 recites the limitation that the sealing bead extends around the outer edge of the flapper valve. Thus the combination of these two claims clearly suggests to one of ordinary skill in the art that the valve shape is circular.

14. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 of U.S. Patent No. 6,699,129. Claim 6 of U.S. Patent No. 6,699,129 recites all of the limitations with the exception of explicitly disclosing the bead to have a half-circle cross section. The applicant should note that a change in the shape of a prior art device is a design consideration that involves only routine skill in the art. In re Dailey, 357 F. 2d 669, 149 USPQ 47 (CCPA 1966).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caruso discloses a flexible disc valve. Hegler et al. and Welschof et al. disclose vent mechanism for a universal joint. Hudson, Jr. discloses a Low inertia check valve. Oldenburg discloses an assembly vent for boot/seal installation. Townsend et al. discloses a vent valve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (703) 305 - 5295. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Scherbel, can be reached on (703) 308 - 1272. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 - 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 - 0861.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Ramesh Krishnamurthy". The signature is written in a cursive, flowing style with a large initial 'R'.

Ramesh Krishnamurthy
Examiner
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